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Ser. No.: 10/757,298 Filing Date: January 14, 2004 Docket No. ISIS0038-100 (CHEM0001US)
Matter No.: 147319
Title: Modified Oligonucleotides For Use In Gene Modulation Pages to Follow: 4
Sender's Name: Paul K. Legaard, Ph.D. Date: July 8, 2005

RECIPIENT(S)	COMPANY/FIRM	FAX
Tracy Ann Vivlemore	USPTO, GAU 1635	(703) 872-9306

MESSAGE: OFFICIAL FAX

PLEASE DELIVER TO EXAMINER VIVLEMORE.

ATTACHED IS:

1. Transmittal Form (1 page); and
2. Response to the Restriction Requirement (3 pages).

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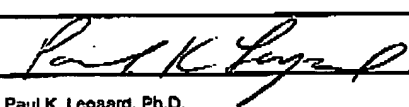
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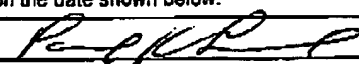
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)		Application Number	10/757,298
		Filing Date	January 14, 2004
		First Named Inventor	Robert S. Andrews
		Art Unit	1835
		Examiner Name	Tracy Ann Vivemore
Total Number of Pages in This Submission	4	Attorney Docket Number	ISIS0038-100 (CHEM0001US)

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
<div style="border: 1px solid black; padding: 2px;">Remarks</div>		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm	Cozen O'Connor		
Signature			
Printed Name	Paul K. Legaard, Ph.D.		
Date	8 July 2005	Reg. No.	38,534

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Signature			
Typed or printed name	Paul K. Legaard, Ph.D.	Date	8 July 2005

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DOCKET NO.: ISIS0038-100 (CHEM0001US)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Andrews, Boswell, and Ward

Serial No.: 10/757,298

Group Art Unit: 1635

Filed: January 14, 2004

Examiner: Tracy Ann Vivlemore

Title: **MODIFIED OLIGONUCLEOTIDES FOR USE IN GENE MODULATION**

Certificate of Facsimile Transmission

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office to facsimile number (703) 872-9306 on the date shown below.

On 8 JULY 2005


Paul K. Legaard Reg. No. 38,534

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

RESPONSE TO THE RESTRICTION REQUIREMENT

The present Response is filed in regard to the Restriction Requirement mailed June 28, 2005 in connection with the above-identified patent application.

The Examiner has mistakenly restricted claims 1-40 into sixteen (16) groups. Applicants elect Group I, containing claims 1-5, 8-12, and 38 with traverse.

The Office Action asserts that Groups I-XIII are unrelated because the compounds claimed therewithin, which are oligomeric compounds comprising a protected phosphate group, have "different chemical structures" and "different effects" such as "differing levels of nuclease resistance or differing chemical reactivities." That the compounds in each of the designated thirteen groups comprise "different chemical structures", however, is of no consequence in a restriction requirement analysis. Indeed, if compounds having "different chemical structures" were to be taken into account in such an analysis, then only one compound per application would be mandated. Such a result, fortunately, is not provided within the MPEP. In addition, whether or

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PATENT

not a compound would have a different level of any particular activity compared to another compound also has no bearing in a restriction requirement analysis. The proper analysis is whether the compounds would have "different effects" not different levels of a particular effect. Indeed, it is quite possible that two compounds in the same Group may differ in the level of nuclease resistance (e.g, one compound in a particular group may have a half-life that is 2% longer than another compound in the same group). Thus, the reasons provided in the Office Action do not support restriction between Groups I-XIII.


Even if the Office Action still considers the thirteen groups of claims to be patentably distinct, §803 of the M.P.E.P. mandates two criteria for a proper requirement for restriction: 1) the inventions must be independent or distinct; and 2) there must be a serious burden on the examiner. Use of different "keywords" in searching does not constitute a "serious burden." Rather, for purposes of initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in M.P.E.P. §808.02. Significantly, the Examiner has not met the *prima facie* burden. Indeed, the Examiner has not shown separate status in the art or a requirement for a different field of search. Further, each of the thirteen groups of claims has, in fact, been classified into identical classes (class 536) and subclasses (subclass 24.5), thus, strongly indicating a lack of serious burden. Accordingly, claims 1-33 and 38 should be examined together in the present application without restriction.

If the Office Action persists in applying the present restriction, Applicants presume that any prior art that is found relating to one particular protected phosphate group, to the extent that such prior art exists, will not be used in an obviousness rejection against a compound having a different protected phosphate group.

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Applicants submit that the present response is complete and complies with the requirements of 35 U.S.C. §121. In addition, Applicants submit that, at a minimum, claims 1-33 and 38 must be considered in the present application without restriction.

Respectfully submitted,


Paul K. Legaard
Registration No. 38,534

Date: 8 July 2005

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